

REMARKS

Claims 1-49 and 52-55 were pending and presented for examination. In an Office Action dated January 12, 2007, claims 1-49 and 52-55 were rejected. Applicants thank the Examiner for examination of the claims pending in this application and address the Examiner's comments below.

Applicants herein amend claims 1, 4, 41 and 52 and add claims 56-61. These changes are believed not to introduce new matter, and their entry is respectfully requested. Based on the above Amendments and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

In response to the Notice of Non-Compliant Amendment mailed April 5, 2007, Applicants have replaced the status identifier "Previously Amended" with "Previously Presented" as requested, although Applicants believe that the prior Amendment was proper pursuant to MPEP 714(II)(C)(E).

Response to Rejections Under 35 USC 103(a)

In the Office Action, the Examiner rejects the following claims under claims 35 USC § 103(a) as allegedly being anticipated by Sugiyama in view of Constantin and Mochimaru: 1-3, 16, 21, 24, 25, 41, 42, 47, and 52-55.

As will be discussed below, there is no suggestion or motivation to combine Sugiyama, Constantin and Mochimaru. Moreover, Sugiyama, Constantin and/or Mochimaru, alone or in combination, do not disclose or suggest the claims as amended.

Claim 1 has been amended to recite a printer system for printing time-based media comprising:

a printing sub-system within the printer system for receiving and printing standard document formats;

an interface within the printer system for receiving the time-based media data from a media source, the interface coupled to the printing sub-system;

a multimedia processing system within the printer system and coupled to the interface, the multimedia processing system **configured for distributing between the multimedia processing system within the printer system and a system external to the printer system determination** of an electronic representation and a printed representation of the time-based media, wherein the **determination is carried out in part by the multimedia processing system within the printer system and in part by the system external to the printer system;**

a first output device within the printer system in communication with the multimedia processing system to receive the electronic representation, the first output device for producing a corresponding electronic output from the electronic representation of the time-based media; and

a second output device within the printer system in communication with the multimedia processing system to receive the printed representation, the second output device for producing a corresponding printed output from the printed representation of the time-based media.

Claim 41 has also been amended to recite a method for printing time-based media comprising:

receiving and printing standard document formats in response to user input;

receiving the time-based media data from a media source;

automatically determining an electronic representation **and a printed representation** of the time-based media, wherein the **determining is distributed by a media processing system within a printer system between the media processing system and a system external to the printer system;**

generating a corresponding electronic output from the electronic representation of the time-based media; and

generating a corresponding printed output from the printed representation of the time-based media.

Constantin, Sugiyama and Mochimaru, alone or in combination, fail to recite these elements. In particular, none of these references discloses the element “determining an electronic representation and a printed representation of the time-based media, wherein the determining is distributed by a media processing system within a printer system between the media processing system and a system external to the printer system.” By carrying out some of the processing on the printer system and some of the processing external to the printer system, the claimed invention distributes the processing load.

Sugiyama and Mochimaru are directed toward a video printer. (Abstract) They do not discuss “determining an electronic representation and a printed representation of the time-based media, wherein the determining is distributed by a media processing system within a printer system between the media processing system and a system external to the printer system.”

In Sugiyama, the only possible “external system” is the device from which the video signal originates, such as a video or still camera. (Sugiyama, Fig. 1; col. 3, lines 12-26). However, there is simply no disclosure that the camera discussed in Sugiyama receives distribution signals from the printer of Sugiyama to determine a representation of the time-based media.

In Mochimaru, there is no disclosure of any system external to the printer that receives distribution signals from the printer.

Constantin discusses a method and apparatus of routing and processing document images sent using a digital scanner and transceiver. (Abstract) It fails to disclose determining an electronic representation and a printed representation of the time-based media, wherein the determining is distributed by a media processing system within a printer system between the media processing system and a system external to the printer system.

With respect to both claims 1 and 41, the cited art provides no suggestion or teaching to combine the references. To demonstrate motivation, the Examiner refers to paragraph 9 of Constantin, which states:

The present invention is directed to a flexible method and apparatus for control of the routing and processing of documents by a document-receiver. The sender need not know how the receiver classifies the document sent to him or anything about how the receiver intends to route or process the document. The document-receiver may easily establish and change document classifications and document routing and processing instructions.

However, this statement does not articulate any motivation to combine the video printer of Sugiyama with the document processing system of Constantin.

The Examiner also states that a “further suggestion for combining would have been that the interface of Sugiyama requires a video signal input in order to have data upon which to operate...Constantin simply provides the required video signal.” However, the statement that a signal is needed in one system and available from another system does not articulate any motivation to combine the two systems.

The Federal Circuit has held that even where the combination of the references teach every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obvious is improper. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (the Examiner must show “reasons that the skilled artisan, confronted with the same problem as the inventor, and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed”). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999); MPEP 2143.01. Thus, the motivation to combine must be

particularized, and the required evidence cannot be substituted with a generalized goal, as the Examiner has done in the present case.

The particularity needed to establish a motivation to combine references was further discussed in In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002). In In re Lee, the Board had determined that it was not necessary to present a source of a teaching, suggestion, or motivation to combine the references because the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art. However, the Federal Circuit reversed the Board of Patent Appeals and Interferences' decision and stated: "The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent ... cannot be dispensed with. The need for specificity pervades this authority." The Federal Circuit further stated that omitting the need for a specific suggestion in a particular reference to support the motivation to combine was both a legal error and arbitrary agency action. Id. at 1434. Thus, the generalized motivation to combine fails to rise to the level of particularity required by the Federal Circuit. In the present case, the Examiner has not met the required specificity to establish a motivation to combine the references.

Applicants further submit that the claimed invention, as amended, is not disclosed or rendered obvious by any of the other cited references: Wendelken, Hymel, Shieh, Chino, Stevens, Leman, Dygert, Gerber, Heilweil, Huberman, Ohnishi, Schroath, and/or Klatt, either alone or in combination with Sugiyama, Constantin and/or Mochimaru.

In addition, claims 4-29, 31-40, 52, 53, and 56-59 recite additional limitations and are dependent on amended claim 1. Claims 43-49, 54-55, and 60-61 recite additional limitations and are dependent on amended claim 41.

Particularly regarding claim 27, the Examiner correctly recognizes that Sugiyama in view of Constantin and Mochimaru does not disclose “that the multi-media processing system is configured to generate a web page representation of the multi-media.” The Examiner states that “Huberman discloses generating a web page representation of multimedia data” because for the “page to exist with multi-media data...it is inherent that said web page is generated.” (1/12/07 Office Action at page 19) However, Huberman does not disclose “a multimedia processing system coupled to an interface for receiving the time-based media data” that “generates” a web page; it merely “analyzes collections of linked documents (i.e. Web Pages)” that already exist. (Huberman, col. 3, ln. 30-34) In fact, Huberman provides no disclosure whatsoever in the cited portions of how the web pages are generated. That a web page may have “multi-media content” does not disclose that such a web page was generated by “a multimedia processing system coupled to an interface for receiving the time-based media data.” Thus, none of the listed citations discloses or renders obvious “the multimedia processing system [] configured to generate a web page representation of the multimedia,” as recited by Applicants’ claim 27.

Applicants respectfully submit that the pending claims are now allowable over the cited art of record and request that the Examiner allow this case.

Conclusion

In sum, Applicants respectfully submit that claims 1, 4-29, 31-41, 43-49, and 52-61, as presented herein, are patentably distinguishable over the cited references (including references cited, but not applied). Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them. Applicants respectfully invite the

Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully submitted,
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